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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

MOORE, JAMES K

ART UNIT	PAPER NUMBER
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2686

DATE MAILED: 09/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/938,290

Applicant(s)

KOSKELAINEN, PETRI

Examiner

James K Moore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15-30 and 32-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15-19, 21, 23-30, 34, 35 and 37-40 is/are rejected.
- 7) ☒ Claim(s) 20, 22 and 36 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application)
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____

- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed July 31, 2003 have been fully considered but they are not persuasive.

Regarding claims 1-9, 18, 19, 21, 23-26, and 32-35, the applicant argues that it is not inherent that Sasuta's subscription message contains a unique indication of a particular user. See pages 12-13 of the arguments. However, the examiner disagrees. In response to receiving a subscription message (service request) from a communication unit, a communication resource allocator searches entries in a database corresponding to the communication unit. See Sasuta, col. 3, lines 31-49. The examiner is unaware of any way that the communication resource allocator could identify which communication unit entry to search for other than by receiving an identification of the communication unit in the subscription message. This position is also supported by Grube et al. (U.S. Patent No. 5,440,758), which discloses that it is necessary for all service requests to include a communication unit identification so that the requests may be validated by the wireless communication system. See col. 1, lines 53-61.

The applicant also argues that it is not inherent that Rosenberg's subscription message contains a unique indication of a particular user. See pages 12-13 of the arguments. The examiner does not agree. Rosenberg' subscription message is an SIP SUBSCRIBE message. The applicant admits in paragraph 5 of page 4 of the specification that SIP SUBSCRIBE messages contain From and To headers, which, as

is well known, indicate a particular user. Donovan also illustrates that an SIP SUBSCRIBE message used to subscribe to the presence of a user contains a header indicating a particular user whose presence information is requested (e.g., "Subscribe sip:bob@dynamicsoft.com").

2. Applicant's arguments with respect to claims 10-13, 15-17, and 27-30 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

3. Claim 40 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 40 only claims that the unique identification of the particular user in claim 32 comprises identification of the particular user.

Claim Rejections - 35 USC § 102

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1-7, 32-35, and 37-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Sasuta (U.S. Patent No. 5,313,653).

Regarding claims 1 and 38, Sasuta discloses a method comprising storing service information concerning a user in a registrar (communication resource allocator system service database), and sending a subscription message (service request) from a user terminal (communication units 102-105) to the registrar. It is inherent that a header in the subscription message contains a unique indication of a particular user (the user terminal ID) because the communication resource allocator must know the ID of the user terminal in order to respond to it. For example, in response to receiving the subscription message, the communication resource allocator references a database to determine whether the user terminal which sent the message is allowed to perform a selected service. The method also comprises, in response to the subscription message, returning a notification message to the user terminal. The payload of the notification message includes service information for the user to be used by the user terminal for communication services. See Figure 1 and col. 3, line 9 through col. 4, line 26.

Regarding claim 2, Sasuta discloses all of the limitations of claim 1, and also discloses that the user has a plurality of ongoing communication services at the time that the subscription message is sent. See col. 2, line 58 through col. 3, line 8.

Regarding claim 3, Sasuta discloses all of the limitations of claim 2, and also discloses that the payload of the notification message may include information for each one of the ongoing communication services. See col. 4, lines 1-26.

Regarding claim 4, Sasuta discloses all of the limitations of claim 1. Sasuta also anticipates that the subscription message may be sent after the user terminal experiences a failure.

Regarding claim 5, Sasuta discloses all of the limitations of claim 4, and also discloses that the service information included in the payload of the notification message enables recovery of communication services to their state at the time of the terminal failure. For example, if the terminal loses a connection while it is involved with a facsimile transmission, it may recover to the facsimile transmission state by retransmitting a system service request. See col. 1, lines 31-54 and col. 3, lines 9-49.

Regarding claim 6, Sasuta discloses all of the limitations of claim 1. Furthermore, the subscription message may be sent by a new terminal after the user switches terminal from a previous terminal to the new terminal.

Regarding claim 7, Sasuta discloses all of the limitations of claim 1, and a new terminal may be a different type of mobile terminal than a previous mobile terminal.

Regarding claims 32 and 40, Sasuta discloses a mobile terminal that receives a plurality of communication services, and sends a subscription message to a registrar (communication resource allocator system service database). It is inherent that a header in the subscription message contains a unique identification of a particular user (the user terminal). The mobile terminal also receives a notification message sent from the registrar in response to the subscription message. The payload of the notification message includes service information for the communication services. The mobile

terminal also uses the service information to continue the communication services. See Figure 1 and col. 3, line 9 through col. 4, line 26.

Regarding claim 33, Sasuta discloses all of the limitations of claim 32. Additionally, the subscription message may be sent after the mobile terminal experiences a failure.

Regarding claim 34, Sasuta discloses all of the limitations of claim 33, and also discloses that the service information included in the payload of the notification message enables recovery of communication services to their state at the time of the terminal failure. For example, if the terminal loses a connection while it is involved with a facsimile transmission, it may recover to the facsimile transmission state by retransmitting a system service request. See col. 1, lines 31-54 and col. 3, lines 9-49.

Regarding claim 35, Sasuta discloses all of the limitations of claim 34. Furthermore, the subscription message may be sent by the mobile terminal after the user switches to the mobile terminal from a previous mobile terminal.

Regarding claim 37, Sasuta discloses all of the limitations of claim 1, and also discloses that the unique indication comprises an event name (request to perform a selected service) particular to the user.

Regarding claim 39, Sasuta discloses all of the limitations of claim 32, and also discloses that the unique identification comprises an event name (request to perform a selected service) particular to the user.

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6. Claims 1, 8, 9, 18, 19, 21, 23-26, 37, and 38 are rejected under 35 U.S.C. 102(a) as being anticipated by Rosenberg ("SIP and Instant Messaging").

Regarding claim 1, Rosenberg discloses a method comprising storing service information (presence data) concerning the user in a registrar, and sending a subscription message (SUBSCRIBE) from a user terminal to the registrar. A header in the subscription message inherently contains a unique indication of a particular user. The method also comprises, in response to the subscription message, returning a notification message (NOTIFY) to the user terminal. The payload of the notification message includes service information (presence data) for the user to be used by the user terminal for communication services (instant messaging).

Regarding claim 8, Rosenberg discloses all of the limitations of claim 1, and also discloses that the communication services include a push service and that the registrar is a push proxy.

Regarding claim 9, Rosenberg discloses all of the limitations of claim 8, and it is inherent that the push proxy is storing the service information when the user terminal subscribes to the communication services.

Regarding claim 18, Rosenberg discloses all of the limitations of claim 1, and also discloses that the registrar comprises a SIP registrar, the subscription message comprises a SIP SUBSCRIBE message, the header comprises an event header, and the notification message comprises a SIP NOTIFY response.

Regarding claim 19, Rosenberg discloses all of the limitations of claim 18, and it is inherent that the user may have a plurality of ongoing communication services at the time that the SIP SUBSCRIBE message is sent.

Regarding claim 21, Rosenberg discloses all of the limitations of claim 18. In addition, the SIP SUBSCRIBE message may be sent after the user terminal experiences a failure.

Regarding claim 23, Rosenberg discloses all of the limitations of claim 18. In addition, the SIP SUBSCRIBE message may be sent by a new terminal after the user switches terminals from a previous terminal to the new terminal.

Regarding claim 24, Rosenberg discloses all of the limitations of claim 18. In addition, the new terminal may be a different type of mobile terminal than a previous mobile terminal.

Regarding claim 25, Rosenberg discloses all of the limitations of claim 18, and also discloses that the communication services include a push service and that the SIP registrar is a push proxy.

Regarding claim 26, Rosenberg discloses all of the limitations of claim 25, and it is inherent that the push proxy is storing the service information when the user terminal subscribes to the communication services.

Regarding claims 37 and 38, Rosenberg discloses all of the limitations of claim 1, and it is inherent that the unique indication comprises an event name particular to a specific user and identifying the user, since the subscription message must indicate which particular user's presence information the user is subscribing to.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 10-13 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donovan ("IMPS – Instant Messaging and Presence Using SIP") in view of Holmes-Kinsella (U.S. Patent Application Publication No. 2002/0147000).

Regarding claim 10, Donovan discloses a network architecture comprising a plurality of terminals and an inherent radio access network. The radio access network inherently contains elements providing information indicating the presence of the terminals. The network architecture also comprises a presence server. The presence server receives the information indicating the presence of the terminals. The network architecture also comprises an inherent communication service provider which provides a plurality of communication services, and a proxy server. The proxy server provides the communication services (instant messaging services) to the user terminals upon subscription thereto, stores and maintains service information (presence information) related to the communication services, and provides the service information in a single message (NOTIFY) sent in response to a request (SUBSCRIBE) from a user terminal. Donovan does not disclose that the proxy server resubscribes the user to ongoing

subscription for which service information is stored when the proxy server receives the request from a user terminal.

Holmes-Kinsella discloses a system a method for adding new devices to a user's ongoing subscription. See Abstract. Adding a new device of a user to a user's subscription reads on resubscribing the user to an ongoing subscription. Holmes-Kinsella's system comprises a service provider which comprises a inherent server. The service provider's server acts as a proxy for information providers. See Figure 1 and paragraph 16. When a user having ongoing subscriptions requests services from the service provider server with a new device, the service provider server resubscribes the user to the ongoing subscriptions by updating the user's subscriptions to include the new device. See paragraphs 21 and 22. The main benefit of Holmes-Kinsella's invention is that a user may add new devices to the user's pre-existing subscriptions as they are acquired. See paragraphs 6-8. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Donovan with Holmes-Kinsella, such that the proxy server resubscribes the user to ongoing subscription for which service information is stored when the proxy server receives the request from a user terminal, in order to allow the user to add new devices to the user's ongoing subscriptions as they are acquired.

Regarding claim 11, Donovan in view of Holmes-Kinsella teaches all of the limitations of claim 10, and Donovan also discloses that the proxy server provides the service information in the payload of a notification message (NOTIFY) sent to the requesting terminal in response to the request.

Regarding claim 12, Donovan in view of Holmes-Kinsella teaches all of the limitations of claim 11, and Donovan also discloses that the presence server, the proxy server, and the user terminal send message to each other according to SIP and that the notification message comprises a SIP NOTIFY response.

Regarding claim 13, Donovan in view of Holmes-Kinsella teaches all of the limitations of claim 12, and Donovan also discloses that the request comprises a SIP SUBSCRIBE message.

Regarding claim 15, Donovan in view of Holmes-Kinsella teaches all of the limitations of claim 11. Furthermore, Donovan's user terminal may send the request after it experiences failure.

Regarding claim 16, Donovan in view of Holmes-Kinsella teaches all of the limitations of claim 11. In addition, when a user switches to a new user terminal from a previous user terminal, the new user terminal may send the request to the proxy server.

Regarding claim 17, Donovan in view of Holmes-Kinsella teaches all of the limitations of claim 16, and a new terminal may be a different type of user terminal than a previous user terminal.

9. Claims 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenberg in view of Holmes-Kinsella.

Regarding claim 27, Rosenberg discloses a proxy server which provides a plurality of communication services (instant messaging services) to a plurality of user terminals upon subscription of the user terminals to the communication services, stores

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and maintains service information (presence information) related to the communication services, and provides the service information in a single message (NOTIFY) sent in response to a request (SUBSCRIBE) from a user terminal. Rosenberg does not disclose that the proxy server resubscribes the user to ongoing subscriptions for which service information is stored when the proxy server receives the request from a user terminal.

Holmes-Kinsella discloses a system a method for adding new devices to a user's ongoing subscription. See Abstract. Adding a new device of a user to a user's subscription reads on resubscribing the user to an ongoing subscription. Holmes-Kinsella's system comprises a service provider which comprises a inherent server. The service provider's server acts as a proxy for information providers. See Figure 1 and paragraph 16. When a user having ongoing subscriptions requests services from the service provider server with a new device, the service provider server resubscribes the user to the ongoing subscriptions by updating the user's subscriptions to include the new device. See paragraphs 21 and 22. The main benefit of Holmes-Kinsella's invention is that a user may add new devices to the user's pre-existing subscriptions as they are acquired. See paragraphs 6-8. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Rosenberg with Holmes-Kinsella, such that the proxy server resubscribes the user to ongoing subscription for which service information is stored when the proxy server receives the request from a user terminal, in order to allow the user to add new devices to the user's ongoing subscriptions as they are acquired.

Regarding claim 28, Rosenberg in view of Holmes-Kinsella teaches all of the limitations of claim 27, and Rosenberg also discloses that the proxy server provides the service information in the payload of a notification message (NOTIFY) to the requesting user terminal.

Regarding claim 29, Rosenberg in view of Holmes-Kinsella teaches all of the limitations of claim 28, and Rosenberg also discloses that the proxy server sends and receives messages according to SIP and that the notification message comprises a SIP NOTIFY response.

Regarding claim 30, Rosenberg in view of Holmes-Kinsella teaches all of the limitations of claim 29, and Rosenberg also discloses that the request comprises a SIP SUBSCRIBE message.

Allowable Subject Matter

10. Claims 20, 22, and 36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ken Moore, whose telephone number is (703) 308-6042. The examiner can normally be reached on Monday-Friday from 8:30 AM - 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold, can be reached at (703) 305-4379.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Ken Moore

8/28/03

JKM

Marsha D Banks-Harold
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